

ESTTA Tracking number: **ESTTA468919**

Filing date: **04/24/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91195943
Party	Plaintiff Integrated Management Information, Inc.
Correspondence Address	CHERYL L BURBACH HOVEY WILLIAMS LLP 10801 MASTIN BOULEVARD SUITE 1000, 84 CORPORATE WOODS OVERLAND PARK, KS 66210 UNITED STATES clb@hoveywilliams.com, litigation@hoveywilliams.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Cheryl L. Burbach
Filer's e-mail	clb@hoveywilliams.com, litigation@hoveywilliams.com
Signature	/Cheryl L. Burbach/
Date	04/24/2012
Attachments	Opposer's Redacted Trial Brief.pdf (30 pages)(187962 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Integrated Management Information, Inc.)	
)	
Opposer,)	
)	
v.)	Opposition No. 91195943
)	
Frank Barrie)	
)	
Applicant.)	

CONFIDENTIAL - TRADE SECRET/COMMERCIALY SENSITIVE

**OPPOSER INTEGRATED MANAGEMENT INFORMATION, INC.'S REDACTED TRIAL BRIEF
FOR PUBLIC VIEWING**

Respectfully Submitted,

Cheryl L. Burbach
HOVEY WILLIAMS LLP
10801 Mastin Boulevard, Suite 1000
Overland Park, KS 66210
Phone: 913-647-9050
Fax: 913-647-9057
Email: clb@hoveywilliams.com

*Attorneys for Opposer
Integrated Management Information, Inc.*

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	DESCRIPTION OF THE RECORD.....	2
III.	ISSUE PRESENTED.	2
IV.	STATEMENT OF FACTS.....	3
	A. IMI’s Prior Trademark Use of WHERE FOOD COMES FROM and WHERE FOOD COMES FROM VERIFIED (and Design).	3
	B. Applicant’s Application for KNOWWHEREFOODCOMESFROM.COM (and Design).	6
V.	STATEMENT OF LAW AND ARGUMENT.....	7
	A. IMI Has Used its Service Marks Before Applicant Filed the Opposed Application	7
	B. There is a Likelihood of Confusion Between WHERE FOOD COMES FROM and KNOWWHEREYOURFOODCOMESFROM.COM as the Marks are Used with Virtually Identical Services, Advertised through the Same Media, Delivered Through Similar Channels of Trade to Similar Customers	8
	1. The Standard for Likelihood of Confusion.....	8
	2. WHERE FOOD COMES FROM is Similar in Appearance, Sound and C o m m e r c i a l I m p r e s s i o n t o KNOWWHEREYOURFOODCOMESFROM.COM.	10
	3. IMI and Applicant’s Both Offer Identical and Closely-Related Services Under Their Respective Marks.....	13
	4. IMI and Applicant Serve a Significantly and Overlapping Group of Consumers.....	17
	5. High Consumer Sophistication is Not Required to Receive or Use the Services of the Parties.....	18

6.	IMI and Applicant Employ Similar Trade Channels, Marketing Strategies, and Methods	19
7.	No Other Registrants Have Adopted Similar Marks for Use on Similar Services.....	20
8.	Consumers of Applicant Would Reasonably Expect That Applicant is Associated with IMI.	21
9.	Any Doubt Should be Resolved in Favor of IMI.	22
VI.	CONCLUSION.....	23

TABLE OF AUTHORITIES

Statutes & Rules

37 C.F.R. § 2.128.....	1
15 U.S.C. § 1052(d).....	7
15 U.S.C. § 1063.	8
Section 1209.03, Trademark Manual of Examination Procedures.	12
Section 1215.01, Trademark Manual of Examination Procedures.	12
Section 13 of the Lanham Act.	8
Section 2(d), Lanham Act	7
Section 801, Trademark Manual of Board Procedure.	1

Cases

<i>Century 21 Real Estate Corp. v. Century Life of Am.</i> , 970 F.2d 874 (Fed. Cir. 1992).	22
<i>Cunningham v. Laser Golf Corp.</i> , 222 F.3d 943(Fed. Cir. 2000)	11
<i>Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.</i> , 604 F.2d 200(2d Cir. 1979). ...	13
<i>Gen. Foods Corp. v. Wisconsin Bottling, Inc.</i> , 190 U.S.P.Q. 43 (T.T.A.B. 1976).	10
<i>Hunt Foods and Indus., Inc. v. Gerson Stewart Corp.</i> , 367 F.2d 431 (C.C.P.A. 1966).	20
<i>In re Diet Ctr., Inc.</i> , 4 U.S.P.Q.2d 1975 (T.T.A.B. 1987)	13
<i>In re Dixie Restaurants Inc.</i> , 105 F.3d 1405, 41 U.S.P.Q.2d (Fed. Cir. 1997)	12
<i>In re E.I. du Pont de Nemours & Co.</i> , 177 U.S.P.Q. 563, 476 F.2d 1357(CCPA 1973).....	9-11

<i>In re Hyper Shoppes (Ohio), Inc.</i> , 837 F.2d 463, 6 U.S.P.Q.2d 1025(Fed. Cir. 1988).	12, 22
<i>In re Mack</i> , 197 U.S.P.Q. 755 (T.T.A.B.1977).	11
<i>In re Martin’s Famous Pastry Shoppe, Inc.</i> , 748 F.2d 1565 (Fed. Cir. 1984)	13
<i>In re Nat’l Data Corp.</i> , 224 U.S.P.Q. 749, 753 F.2d 1056, 1058 (Fed. Cir. 1985).	11
<i>In re Sawyer of Napa, Inc.</i> , 222 U.S.P.Q. 923 (T.T.A.B.1983).	11
<i>In re Shell Oil Co.</i> , 992 F.2d 1204, 26 U.S.P.Q.2d 1687 (Fed. Cir. 1993).	12, 23
<i>In re Starcraft Corp.</i> , 18 U.S.P.Q.2d 1163 (T.T.A.B. 1990).	21
<i>Kellogg Co. v. Pack ‘Em Enter., Inc.</i> , 14 U.S.P.Q. 1545 (T.T.A.B. 1990), <i>aff’d</i> 21 F.2d 330 (Fed. Cir. 1991).	9
<i>Mutual of Omaha Ins. Co. v. Novak</i> , 5 U.S.P.Q.2d 555 (7th Cir. 1976).	21
<i>Octocom Sys., Inc. v. Houston Comp. Serv. Inc.</i> , 918 F.2d 937, 16 U.S.P.Q.2d 1783 (Fed. Cir. 1990)	14, 19
<i>Otto Roth & Co. v. Universal Foods Corp.</i> , 640 F.2d 1317 (C.C.P.A. 1981).	7
<i>Purolator, Inc. v. Efra Distributors, Inc.</i> , 524 F. Supp. 471, 213 U.S.P.Q. 961(D.P.R. 1981). . .	11
<i>Syntex Labs, Inc. v. Norwich Pharmacal Co.</i> , 437 F.2d 566 (2d Cir. 1971).	13
<i>T.A.B. Sys. v. Parcel Teletrac</i> , 77 F.3d 1372, 37 U.S.P.Q.2d 1879 (Fed. Cir. 1996).	7
<i>Tektronix, Inc. v. Daktronics, Inc.</i> , 534 F.2d 915 (C.C.P.A. 1976).	11
<i>W.W.W. Pharm. Co. v. Gillette Co.</i> , 984 F.2d 567, 25 U.S.P.Q.2d 1593 (2d Cir. 1993).	18
<i>Wella Corp. v. California Concept Corp.</i> , 558 F.2d 1019(C.C.P.A. 1977).	12

I. INTRODUCTION

Opposer Integrated Management Information, Inc. (hereafter “IMI” or “Opposer”) has continuously used the marks WHERE FOOD COMES FROM and WHERE FOOD COMES FROM VERIFIED (and Design) in connection with its services before the Applicant used the KNOWWHEREYOURFOODCOMESFROM.COM (and Design) trademark or filed the opposed application. IMI uses its WHERE FOOD COMES FROM marks with for food quality verification services, namely, verifying the origin and handling practices of food production. Similarly, Applicant, Frank Barrie (hereafter “Applicant” or “Barrie”) seeks to register the mark KNOWWHEREYOURFOODCOMESFROM.COM, Serial No. 77/883,973 for

“Promoting health and environmental awareness within people so that they can lead a clean and healthy life; Promoting public awareness of shopping locally; Promoting public awareness of the need for sustaining local agriculture; Promoting the goods and services of others by providing a web site at which users can link to local agriculture sources.”

IMI opposes registration of Applicant’s mark for the services listed in the application on the basis that IMI has continuously used its inherently distinctive service marks since before Applicant began using his service mark or filed his federal trademark application. Applicant’s service mark for a broad range of services related to food sources creates a likelihood of confusion with IMI’s service marks for verifying food sources. IMI’s priority combined with the fact that the services are closely related, warrants judgement in IMI’s favor. IMI is or will likely be damaged should a registration issue granting Applicant nationwide exclusive rights to the opposed mark. Therefore, pursuant to TBMP § 801 and 37 C.F.R. § 2.128, IMI requests an Order denying registration of Application Serial No. 77883973.

II. DESCRIPTION OF THE RECORD

The record consists of the following documents, all of which have been submitted pursuant to IMI's Notice of Reliance filed on November 17, 2011, IMI's registrations for WHERE FOOD COMES FROM, Registration No. 3694440, and WHERE FOOD COMES FROM VERIFIED and Design, Registration No. 3837316; the opposed application for KNOWWHEREYOURFOODCOMESFROM.COM and Design, Serial No. 77883973; pleadings filed with the Board by the parties; and the testimonial depositions of John Saunders, and exhibits thereto. Applicant did not submit any evidence during his testimony period.

III. ISSUE PRESENTED

There is no issue as to priority in this case. The evidence demonstrates conclusively that IMI adopted, used, and established WHERE FOOD COMES FROM and WHERE FOOD COMES FROM VERIFIED (and Design) as its service marks well before Applicant's application filing date or any use in commerce—nearly two years prior.

The issue presented in this proceeding is whether there is a likelihood of confusion between IMI's marks WHERE FOOD COMES FROM and WHERE FOOD COMES FROM VERIFIED (and Design) and Applicant's mark KNOWWHEREYOURFOODCOMESFROM.COM (and Design), such that Applicant's application for registration of his mark should be denied.

IMI submits that the answer is "yes."

IV. STATEMENT OF FACTS

A. IMI's Prior Trademark Use of WHERE FOOD COMES FROM and WHERE FOOD COMES FROM VERIFIED (and Design)

1. For more than 15 years, IMI has been involved in the transparent and authentic transfer of information from the production of agriculture and food products to the consumers who are purchasing that product. [Trial Deposition of John Saunders, taken November 17, 2011 ("Saunders"), 12:18-13:9]. Saunders is the founder, Chairman of the Board and Chief Executive Officer of IMI.

2. To achieve its information transfer verification processes, IMI developed a very highly intensive program of certification and auditing which requires that it provide a staff of certified and trained auditors to perform specific auditing duties while reviewing the information of its customers, these customers ranging from farmers and ranchers, through feeding and growing operations, and on through processors and retailers. [Saunders 13:10-22].

3. IMI has oversight through the United States Department of Agriculture and uses a protocol to trace and verify food sources. [Saunders 13:23-14:14].

4. IMI contracts auditors who are geographically located throughout the country to enable them to efficiently address the needs of food producers in their respective geographic areas. [Saunders 15:9-13].

5. As a result of the verification process, IMI's trademarks are used, in part, to notify consumers at retail and food service locations that the associated food products are produced in compliance with the standards that are being marketed for those products. [Saunders 13:1-9].

6. To promote the verified food products, IMI adopted and uses the wordmark WHERE FOOD COMES FROM, which is the subject of U.S. Registration No. 3694440, registered on October 6, 2009. [Saunders 18:11-19]. The listed services are: "food quality verification services, namely verifying the origin and handling practices of food production." [Saunders Exhibit ("Ex.") 2].

7. IMI selected its WHERE FOOD COMES FROM service mark in 2007. [Saunders 19:9-20-9].

8. IMI first began using its WHERE FOOD COMES FROM service mark in commerce at least as early as 2008. [Saunders 30:6-21]. The WHERE FOOD COMES FROM mark was displayed on IMI's website soon thereafter in early 2008. [Saunders 30:24-31:8].

9. IMI's service trademark is promoted in many ways, including on its website at www.wherefoodcomesfrom.com. [Saunders 45:22-25].

10. Approximately 7,000 to 8,000 online users visit the WHERE FOOD COMES FROM website every month at www.wherefoodcomesfrom.com. [Saunders 126:21-127:6].

11. IMI performed due diligence to determine if the WHERE FOOD COMES FROM word mark was available for use and registration before adopting the mark. [Saunders 20:22-21:8].

12. IMI then hired a company to create the WHERE FOOD COMES FROM design mark. [Saunders 21:20-22:19].

13. Opposer also owns a United States trademark registration for that mark, Registration No. 3837316, to wit:



[Saunders 22:21-23:11; Ex. 3].

14. IMI also owns federal word mark and design mark applications for WHERE FOOD COMES FROM for:

Food source verification services, namely, verifying the origin and handling practices of food production; providing a website for consumers, producers, retailers, and educators to access information regarding the source of food; providing a website that features informational resources regarding the food supply system, producer videos, nutrition, menu management, and other food-related issues.

[Saunders 25:8-19; Saunders Ex. 28]. Those services were used at least as early as October 28, 2008. [Saunders 24:16-25:18; Saunders Ex. 27; Saunders Ex. 28].

15. IMI's WHERE FOOD COMES FROM services are provided throughout the United States. [Saunders 16:25-17:2].

■ [REDACTED]

| [REDACTED]

| [REDACTED]

| [REDACTED]

■ [REDACTED]

[REDACTED]

■ [REDACTED]

| [REDACTED]

| [REDACTED]

| [REDACTED]

B. Applicant's Application for KNOWWHEREFOODCOMESFROM.COM (and Design)

19. On December 2, 2009, Applicant filed his intent-to-use trademark application for KNOWWHEREYOURFOODCOMESFROM.COM (and Design), Serial No. 77883973, which is the subject of this proceeding. It appears as such:



20. The services in that application are for

Promoting health and environmental awareness within people so that they can lead a clean and healthy life; Promoting public awareness of shopping locally; Promoting public awareness of the need for sustaining local agriculture; Promoting the goods and services of others by providing a web site at which users can link to local agriculture sources.

21. Applicant began using his mark in commerce on March 11, 2010. [Discovery Deposition of Frank Barrie (“Barrie”), taken June 30, 2011, 86:19-87:19; Barrie Ex. 16 (Rog. 6)].

22. Applicant admits that he did no searching or investigation to determine if someone else was using a similar mark prior to adopting KNOWWHEREFOODCOMESFROM.COM (and Design). [Barrie 28:21-30:12].

V. STATEMENT OF LAW AND ARGUMENT

Opposer IMI, by its attorneys, Hovey Williams LLP, submits this memorandum in support of its opposition to Barrie's attempt to register the mark KNOWWHEREYOURFOODCOMESFROM.COM and Design on the Principal Register. Section 2(d) of the Lanham Act precludes the registration of a mark that so resembles "a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive[.]" 15 U.S.C. § 1052(d); *T.A.B. Sys. v. Parcel Teletrac*, 77 F.3d 1372, 37 U.S.P.Q.2d 1879, 1881 (Fed. Cir. 1996). The Board should refuse to register Applicant's mark because IMI has prior rights to the word and design marks WHERE FOOD COMES FROM and, accordingly, Barrie's use of the applied-for mark is likely to confuse consumers as to the source of Barrie's goods.

A. IMI Has Used its Service Marks Before Applicant Filed the Opposed Application

To prevail in an opposition based upon likelihood of confusion under Section 2(d) of the Lanham Act, an opposer must demonstrate that it has proprietary rights in the mark it relies upon in the opposition, superior to those of the applicant. The opposer may meet its burden by demonstrating ownership of and prior use of an unregistered mark, prior use in advertising or as a trade name, or any other type of use that has resulted in the identification of the mark with the opposer's goods or services. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320 (C.C.P.A. 1981).

The record establishes that the opposed application for KNOWWHEREYOURFOODCOMESFROM.COM, Serial No. 77883973, was filed on December 2, 2009. IMI, however, began using the service mark WHERE FOOD COMES FROM in commerce

on at least as early as October 28, 2008, and filed its application on May 12, 2009. [Saunders Ex. 28]. Accordingly, IMI's use of its trademark WHERE FOOD COMES FROM forms the basis for refusal of the opposed application under Section 2(d) of the Lanham Act.

B. There is a Likelihood of Confusion Between WHERE FOOD COMES FROM and KNOWWHEREYOURFOODCOMESFROM.COM, as the Marks are Used with Virtually Identical Services, Advertised through the Same Media, and Delivered Through Similar Channels of Trade to Similar Customers

In light of IMI's prior public use of the WHERE FOOD COMES FROM marks, and the closely-related nature of the parties' services, consumers are likely to be confused as to the source of Barrie's services. It follows that the KNOWWHEREYOURFOODCOMESFROM.COM design mark is not registrable. Application of the applicable multi-factored test illustrates the clear likelihood of confusion between the parties' respective marks, and warrants the denial of Barrie's application for registration.

1. The Standard for Likelihood of Confusion

Under Section 13 of the Lanham Act, 15 U.S.C. § 1063, a party may oppose registration of a mark if the party believes it will be damaged by the registration. In the instant case, IMI believes that a likelihood of confusion exists between its WHERE FOOD COMES FROM marks and Applicant's KNOWWHEREYOURFOODCOMESFROM.COM mark, such that customers and prospective consumers of the parties' services will believe that they emanate from the same source. As a result, IMI will be damaged if Applicant is allowed to register his mark.

In determining whether there is a likelihood of confusion between two marks, this Board considers the issue in light of the thirteen evidentiary factors outlined in *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567, 476 F.2d 1357, 1361 (CCPA 1973), "which are of record

and which are pertinent to the case.” *Kellogg Co. v. Pack 'Em Enter., Inc.*, 14 U.S.P.Q. 1545, 1550

(T.T.A.B. 1990), *aff'd* 21 F.2d 330 (Fed. Cir. 1991). These factors include:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods or services as described in the application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made, i.e. “Impulse” vs. careful, sophisticated purchasing;
- (5) The fame of the prior mark (sales, advertising, length of use);
- (6) The number and nature of similar marks in use on similar services;
- (7) The nature and extent of any actual confusion;
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
- (9) The variety of services on which a mark is or is not used (house mark, “family” mark, product mark);
- (10) The market interface between Applicant and the owner of a prior mark:
 - (a) a mere “consent” to register or use;
 - (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party;
 - (c) assignment of mark, application, registration and goodwill of the related business; and
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion;
- (11) The extent to which Applicant has a right to exclude others from use of its mark on its services;
- (12) The extent of potential confusion, i.e., whether *de minimis* or substantial; and
- (13) Any other established fact probative of the effect of use.

du Pont, 476 F.2d at 1361.

The operative issue in this proceeding is whether reasonably prudent purchasers exposed to Applicant's KNOWWHEREYOURFOODCOMESFROM.COM mark, as reflected in the opposed application, would be likely to be confused with respect to IMI's trademark, so as to believe that services bearing, promoted under, and sold under the KNOWWHEREYOURFOODCOMESFROM.COM service mark emanate from, or are somehow connected to, IMI. Because of the similarity between the marks and between the parties' services, consumers and channels of trade, IMI submits that the answer is manifestly "yes," a likelihood of confusion exists.

Indeed, consideration of the facts of the instant matter in light the *du Pont* factors demonstrates that the similarities between the parties' mark, services, consumers and channels of trade far outweigh any dissimilarities. A finding in IMI's favor is, thus, appropriate.

2. WHERE FOOD COMES FROM is Similar in Appearance, Sound and Commercial Impression to KNOWWHEREYOURFOODCOMESFROM.COM

When performing the analysis to determine the similarity of the marks, the marks must be compared for similarities in sound, appearance, and meaning or connotation. *E.I. du Pont*, 476 F.2d at 1361. Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 U.S.P.Q. 755, 757 (T.T.A.B.1977). "[I]t is well established that similarity in any one of the elements of sound, appearance, or meaning is sufficient to indicate a likelihood of confusion." *Gen. Foods Corp. v. Wisconsin Bottling, Inc.*, 190 U.S.P.Q. 43, 45 (T.T.A.B. 1976). The comparison of the marks may give more or less weight to a particular feature provided that the final

conclusion rests on the consideration of the marks in their entireties. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985).

One feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to the dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 (C.C.P.A. 1976). *See also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 947 (Fed. Cir. 2000) (holding that when reviewing the similarities or dissimilarities of two marks, a court can find that one feature of a mark has more significance than another). Where, as here, IMI's entire mark has been subsumed into Barrie's mark, confusing similarity must be found to exist. *See Purolator, Inc. v. Efra Distributors, Inc.*, 524 F. Supp. 471, 213 U.S.P.Q. 961, 965 (D.P.R. 1981); *In re Sawyer of Napa, Inc.*, 222 U.S.P.Q. 923, 924 (T.T.A.B.1983).

The parties' respective marks here are nearly identical. First, the words are virtually identical; Applicant's mark is different only in that it includes the words "know" and "your" while swallowing up IMI's word mark. While Applicant's mark also contains ".com", the Trademark Manual of Examining Procedure explains that

[p]ortions of the uniform resource locator ("URL"), including the beginning, ("http://www.") and the top-level Internet domain name ("TLD") (e.g., ".com," ".org," ".edu,") function to indicate an address on the World Wide Web, and, therefore, generally serve *no source-indicating function*.

TMEP §§1209.03 and 1215.01. It follows that the addition of ".com" also provides no assistance in distinguishing Applicant's service mark from others.

Further, while Barrie has applied for the mark with a design, such does not obviate a likelihood of confusion. It is generally accepted that when a composite mark incorporates the mark of another for closely related goods or services, the addition of other matter is generally insufficient to avoid a likelihood of confusion as to source. *See Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 1022 (C.C.P.A. 1977). “Without doubt the word portions of the two marks are identical, have the same connotation, and give the same commercial impression.” *In re Shell Oil Co.*, 992 F.2d 1204, 26 U.S.P.Q.2d 1687, 1688 (Fed. Cir. 1993). Thus, Barrie’s addition of a design to the words does not serve to distinguish Barrie’s Mark from IMI’s marks. *See In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 U.S.P.Q.2d at 1524 (Federal Circuit held that, despite the addition of the words “The” and “Café” and a diamond-shaped design to registrant’s DELTA mark, there was still a likelihood of confusion). *See also In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 U.S.P.Q.2d 1025, 1026 (Fed. Cir. 1988) (BIGG’S (stylized) for grocery and general merchandise store services found likely to be confused with BIGGS and design for furniture).

Equally significant as the visual similarities in the words is the fact that the design marks are also confusingly similar:



Both marks contain circles and the words appear directly over the top of a circle. Both marks contain images of vegetation. These images convey a similar, if not identical, commercial impression compounds the risk that confusion is likely with nearly identical words. It is highly plausible that

consumers, when not viewing the marks on a side-by-side basis, of course, would come to believe that both of the marks originate with IMI. [Saunders 100:22-101:13].

These are all compelling facts that inevitably lead to the conclusion that the parties' respective marks convey the same commercial impression. Applicant's application would enjoy, and, in fact, appropriate IMI's commercial impression if registered. If registration is permitted, Applicant will benefit from IMI's trademark rights. [Saunders 99:10-100:3]. If registration is permitted, Applicant would also own the colorable exclusive right to KNOWWHEREYOURFOODCOMESFROM.COM by its registration.

3. IMI and Applicant's Both Offer Identical and Closely-Related Services Under Their Respective Marks

The Board has held that the goods or services need not be identical, or even competitive, to find a likelihood of confusion, but that it is sufficient that the goods and services are related in some manner, or the conditions surrounding marketing be such, that they could be encountered by the same purchasers under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that the goods and services come from a common source or originate from the same producer. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1567 (Fed. Cir. 1984) (finding confusion likely between MARTIN'S for bread and MARTIN'S for cheese); *In re Diet Ctr., Inc.*, 4 U.S.P.Q.2d 1975, 1976 (T.T.A.B. 1987) (finding confusion likely between SVELTE for frozen desserts and VEGETABLE SVELTES for crackers). Further, in order to be confused, "a consumer need not believe that the owner of the mark actually produced the item and placed it on the market." *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204 (2d Cir. 1979), citing *Syntex Labs, Inc. v. Norwich Pharmacal Co.*, 437 F.2d 566, 568-9 (2d Cir. 1971).

Rather, the public's belief that the mark's owner sponsored or otherwise approved the use of the trademark satisfies the confusion requirement. *Id.* And "authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services]." *Octocom Sys., Inc. v. Houston Comp. Serv. Inc.*, 918 F.2d 937, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990) (emphasis added).

IMI has been involved in the transparent and authentic transfer of information from the production of agriculture and food products to the consumers who are purchasing such products for more than 15 years. [Saunders 12:18-13:9]. IMI created a very highly intensive program of certification and auditing which requires that it provide a staff of certified and trained auditors to perform specific auditing duties while reviewing the information of its customers, these customers range from farmers and ranchers, through feeding and growing operations, and on through processors and retailers. [Saunders 13:10-22].

IMI verifies food origin claims with more than 6,000 farms and ranches of all sizes in the United States [Saunders 33:15-18], as well as local farmers markets [Saunders 37:21-38:13]. IMI contracts with highly qualified, independent auditors who are geographically located throughout the country to enable them to efficiently address the needs of food producers in their respective geographic areas. [Saunders 15:9-13]. In short, IMI's WHERE FOOD COMES FROM marks are associated with services where the quality and integrity of the services being provided are key.

As an integral part of its verification services, IMI's WHERE FOOD COMES FROM service marks then appear on the food products and in connection with the services of food producers and retailers that have undergone the verification process. [Saunders 28:14-21]. Consumers encounter

the WHERE FOOD COMES FROM mark, for instance, on products in a grocery store or in a restaurant, and are able to immediately utilize either the URL to identify the source of origin on that product or a quick response code, which is immediately recognizable by smart phones, to learn more about the source of origin on the food being purchased. [Saunders 28:4-13].

As part of its consumer-facing services, IMI also uses its WHERE FOOD COMES FROM service mark to provide information to consumers on food-related topics. For instance, IMI's website (at www.wherefoodcomesfrom.com) provides an extensive list and detailed information about beef and pork producers that have been certified. [Saunders 31:9-32:1]. Additionally, IMI's website, among other things, provides information about producers that have sustainable agricultural practices. [Saunders 32:2-6]. Thus, consumers can use IMI's WHERE FOOD COMES FROM services to determine sustainable producers and producers that use humane animal practices. [Saunders 34:13-35:6].

The website also provides information and news on current topics related to food production, food retailers, food service establishments, and restaurants that offer verified food products. [Saunders 33:10-17]. IMI's website bearing the WHERE FOOD COMES FROM service mark also provides recipes. [Saunders 33:18-34:5].

Applicant's application is for a broad listing of services, which directly overlap with the services that were in prior use by IMI in connection with WHERE FOOD COMES FROM. This is troubling since the WHERE FOOD COMES FROM service mark resonates with consumers using the mark with all of the service now sought to be registered by Applicant. [Saunders 34:2-35:6].

In Mr. Saunders deposition, he explained that Applicant's broad services are already being provided by IMI's food verification services in ways that overlap or are identical [Saunders

97:25-98:19]. In being able to trace the source of food, IMI's WHERE FOOD COMES FROM program promotes "health and environmental awareness within people so they can lead a clean and healthy life." [Saunders 93:1-13]. IMI uses its WHERE FOOD COMES FROM marks to promote "public awareness of shopping locally." [Saunders 93:14-94:17]. Similarly, IMI's service marks are used to promote "public awareness of the need for sustaining local agriculture" [Saunders 94:18-95:4] and "the goods and services of others by providing a website which users can link to local agriculture sources" [Saunders 95:5-19].

The overlap and relatedness of Applicant's services is apparent not only in the opposed application itself, but also from Applicant's business plan documents and website. Applicant admitted that he has begun using the mark in commerce for the services identified in the application. [Barrie 34:2-17, 34:18-22]. Applicant initially developed a document entitled "Business Plan", which was produced in this proceeding. [Saunders 82:25-84:19 Saunders Ex.24]. Many of the goals identified match those goals or current services offered by IMI. [Saunders 85:17-86:10]. For instance, IMI promotes sustainable agricultural practices and local farms in connection with the WHERE FOOD COMES FROM service mark. [Saunders 86:11-16]. Nearly all of the services identified in the Business Plan were previously provided by IMI. IMI provides information about:

- local food farmers and producers [Saunders 88:6-12];
- community-supported agricultural enterprises [Saunders 88:6-89:6];
- local farms [Saunders 89:7-20];
- restaurants [Saunders 89:21-23];
- agricultural cooperatives [Saunders 89:24-90:2];
- fair-traded tropical food sources [Saunders 90:3-7];

- books, literature, films, educational programs and seminars in the field of food topics [Saunders 90:8-20];
- local sustainable agricultural and unsustainable industrial agricultural issues [Saunders 91:17-22]; and
- producers and pertinent governmental bodies [Saunders 92:4-9].

Summarily, Applicant's Business Plan focuses on the same issues that IMI is concerned with and with which it uses its WHERE FOOD COMES FROM service marks. [Saunders 96:4-97:24].

If Applicant is permitted to register and use the service mark KNOWWHEREYOURFOODCOMESFROM.COM, he would benefit from IMI's goodwill associated with the WHERE FOOD COMES FROM marks and a registration would confer a colorable claim to exclusive rights of use. IMI has exclusively used its service mark in association with its services prior to Barrie. As such, consumers and potential consumers are likely to be confused as to the respective sources of the services. This factor weighs in favor of IMI.

4. IMI and Applicant Serve a Significantly Overlapping Group of Consumers

This *du Pont* factor, too, leans in IMI's favor. Both IMI and Applicant target the same group of consumers—persons who are seeking information about food sources and other food-related topics. IMI directs its services to a wide array of consumers, which encompasses those targeted by Applicant. Admittedly, IMI's services are offered under the WHERE FOOD COMES FROM service marks to a broad group of organizations and persons, including farmers, ranchers, growers, retailers, restaurants and individual consumers. [Saunders 40:7-41:12]. IMI promotes its WHERE FOOD COMES FROM services to varying sizes and types of farms. [Saunders 86:16-17-87:19]. A natural scope of expansion would also be with farmers markets [Saunders 87:20-88:5].

Applicant concedes that his services are targeted to anyone “who's interested in knowing where their food comes from....” [Barrie 116:15-25]. While Applicant’s services appear to be geared primarily toward individual consumers, it is conceivable that the other types of customers service by IMI would also be involved with Applicant’s services. It is possible ranchers and farms would want to advertise with Applicant. Notably, these types of organizations are already discussed and identified on Applicant’s website, such as restaurants, farmers markets, and community-supported agriculture farms. [Barrie 22:2-7; 22:15-25:6; 41:3-22].

5. High Consumer Sophistication is Not Required to Receive or Use the Services of the Parties

The facts related to this factor signal that confusion as to the source of Applicant’s services is likely. In this instance, anyone with a computer can access and use the parties’ respective services. At this time, only a low level of sophistication is required by individual consumers. [Saunders 75:16-22]. Because the services at issue here are free to consumers, those consumers are likely to access the parties’ websites or receive the information on impulse, further enhancing the likelihood that consumers are likely to believe that IMI, the senior user of WHERE FOOD COMES FROM is the source of or affiliated with the owner of KNOWWHEREYOURFOODCOMESFROM.COM. *See W.W.W. Pharm. Co. v. Gillette Co.*, 984 F.2d 567, 25 U.S.P.Q.2d 1593, 1600 (2d Cir. 1993).

Additionally, although the extent of potential confusion is greatest with individual consumers, other consumers familiar with the WHERE FOOD COMES FROM marks would, upon seeing Barrie’s design mark, be likely to believe that Barrie’s services are sponsored by or somehow associated with IMI. Even if a certain percentage of consumers of IMI’s services were to be considered knowledgeable and sophisticated in the field of food source verification, such would not

mean that they necessarily are knowledgeable and sophisticated in the field of trademarks or immune from source confusion. Any ranchers, restaurants, farmers, farmers markets, or agricultural cooperatives who are aware of IMI's food verification services could reasonably believe, upon encountering Barrie's website and other advertising, that such services emanate from or are sponsored by or affiliated with IMI, given that the word marks at issue are virtually identical and the focus of the respective services is the same.

6. IMI and Applicant Employ Similar Trade Channels, Marketing Strategies, and Methods

IMI and Applicant employ the same channels of trade to provide their respective services. Both use the internet [Saunders 72:16-73:5; Barrie Ex. 8]. In addition, IMI currently delivers its services in person [Saunders 73:6-20], by telephone [Saunders 73:21-22], in grocery stores [Saunders 73:23-24], in restaurants [Saunders 73:25-74:1], on food packaging [Saunders 74:2-7] and on menus [Saunders 107:11; Saunders Ex. 29]. Of course, there are no limitations on trade channels or purchasers in the identification of services in Barrie's application. Thus, the parties' respective services must be considered to move in the same channels of trade, and would be offered to similar classes of consumers. *See Octocom Sys., Inc.*, 918 F.2d at 943. These would include each of the channels recited above.

The parties' respective modes of advertising are likewise the same:

- online on the parties' respective websites (www.wherefoodcomesfrom.com and www.knowwhereyourfoodcomesfrom.com) [Saunders 44:13-21; Saunders Ex. 5; Barrie 97:11-24; Barrie Ex. 9; Barrie Ex. 8; Barrie 134:9-18; Barrie Ex. 17; Barrie Ex. 25];

- social media, such as Facebook [Saunders 46:1-47:24, 62:9-63:2; Saunders Ex. 16; Saunders 63:15-64:6; Saunders Ex. 18; Saunders 64:10-22; Saunders Ex. 19; Barrie Ex. 9];
- print advertising [Saunders 45:15-21, 49:6-21, 51:17-52:1, 60:15-25; Saunders Ex. 14; Saunders 61:8-62:8; Saunders Ex. 15; Saunders 63:3-12; Saunders Ex. 17; Saunders 108:21-25; Barrie 108:15-23]; and
- email [Saunders 51:6-16; Barrie 102:7-25]

In addition, IMI has advertised on television [Saunders 44:22-45:3], on the radio [Saunders 45:4-13], in online sponsored advertising [Saunders 47:25-48:6], at in-person meetings [Saunders 48:7-20], at trade shows [Saunders 48:21-49:5], on food packaging [Saunders 50:9-24, 53:8-57:3; Saunders Exs. 6-10; Saunders 66:19-67:8; Saunders Ex. 20], on point-of-purchase displays [Saunders 50:25-51:5, 59:25-60:12; Saunders Ex. 13], and in press releases distributed to news agencies around the globe [Saunders 58:13-59:4; Saunders Ex. 12, Saunders 67:21-68:17; Saunders Ex. 21; Saunders Ex. 22.] Again, nothing precludes Applicant from exploiting these methods of advertising with his KNOWWHEREYOURFOODCOMESFROM.COM trademark. This factor favors IMI.

7. No Other Registrants Have Adopted Similar Marks for Use on Similar Services

The absence of third-party registrations containing the term WHERE FOOD COMES FROM for related services further demonstrates the strength of IMI's marks. *See Hunt Foods and Indus., Inc. v. Gerson Stewart Corp.*, 367 F.2d 431, 436 (C.C.P.A. 1966); *In re Starcraft Corp.*, 18 U.S.P.Q.2d 1163, 1165 (T.T.A.B. 1990). There is no other evidence that anyone has adopted the

words WHERE FOOD COMES FROM as a service mark for any services, let alone any related services. As such, this factor should be weighed in favor of IMI.

8. Consumers of Applicant Would Reasonably Expect That Applicant is Associated with IMI

In making a likelihood of confusion determination, the operative issue is “whether the viewer of an [allegedly infringing] mark would be likely to associate the product or service with which it is connected with the source of the products or services with which an earlier mark is connected.” *Mutual of Omaha Ins. Co. v. Novak*, 5 U.S.P.Q.2d 555, 562 (7th Cir. 1976). In the instant matter, the clear answer is “yes.” It is likely consumers would believe there to be an affiliation between the parties because of common services and similar service marks. [Saunders 100:22-101:13]. As detailed above, the parties’ marks are virtually identical, and are used in conjunction with virtually identical services which are sold to an overlapping group of consumers through the same channels of trade. These similarities make an association between the marks virtually inescapable.

This is a situation where control of the WHERE FOOD COMES FROM service marks is essential for the viability of IMI’s business. The WHERE FOOD COMES FROM marks are strong and effective in distinguishing IMI’s services from those of others. [Saunders 26:20-27:15]. And IMI consistently uses the registration symbol [Saunders 65:11-23]. The WHERE FOOD COMES FROM service marks are the critical component of IMI’s entire business. [Saunders 27:11-23].

IMI necessarily places great importance on its service marks being associated with a high quality of service due to the need for consumer trust. [Saunders 41:13-43:7]. One way IMI does that is by requiring compliance with its Logo Usage Guide. [Saunders 43:15-44:10; Saunders Ex. 4]. IMI’s licensees are required to follow the guidelines. [Saunders 44:2-10; Saunders 81:22-82:9;

Saunders Ex. 23]. IMI's inability to prevent others from using a similar mark for related services would be especially detrimental, and would damage IMI's licensing program and the integrity of the WHERE FOOD COMES FROM business. [Saunders 100:4-21, 101:14-22].

Barrie admits that he is not aware of USDA regulations and compliance issues. [Barrie 42:14-24]. Yet it is possible he could use his trademark to provide food-source information about unverified food products. IMI would have no ability to prevent his trademark from being used with products that do not comply with governmental regulations or even with products or services that are not actually derived or handled as advertised.

If Applicant is permitted to register KNOWWHEREYOURFOODCOMESFROM.COM, consumers and potential consumers may initially be drawn to KNOWWHEREYOURFOODCOMESFROM.COM, believing there to be an affiliation between it and IMI. And due to the similarities in the marks, IMI is likely to be injured as a result of Applicant's use and registration of KNOWWHEREYOURFOODCOMESFROM.COM.

9. Any Doubt Should be Resolved in Favor of IMI

Any doubt as to likelihood of confusion should be resolved against Applicant. *See Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 878 (Fed. Cir. 1992); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65 (Fed. Cir. 1988). The newcomer "has the opportunity of avoiding confusion, and is charged with the obligation to do so." *In re Shell Oil*, 992 F.2d 1204, 1209 (Fed. Cir. 1993).

VI. CONCLUSION

The application to register the mark KNOWWHEREYOURFOODCOMESFROM.COM should be denied on the basis that there is a likelihood of confusion between it and IMI's WHERE FOOD COMES FROM service mark. IMI's prior usage of its WHERE FOOD COMES FROM marks is documented, continuous, and unchallenged. Significantly, the marks are virtually identical in sight, sound and commercial impression, the parties' services are the same, and are likely delivered to an overlapping group of consumers through the same channels of trade.

There can be little doubt that confusion between WHERE FOOD COMES FROM and KNOWWHEREYOURFOODCOMESFROM.COM is likely and IMI will be harmed. Accordingly, the Opposition to registration should be sustained.

Dated: April 24, 2012

Respectfully Submitted,

/s/ Cheryl L. Burbach
Cheryl L. Burbach
HOVEY WILLIAMS LLP
10801 Mastin Boulevard, Suite 1000
Overland Park, KS 66210
Phone: 913-647-9050
Fax: 913-647-9057
Email: clb@hoveywilliams.com

*Attorneys for Opposer
Integrated Management Information, Inc.*

CERTIFICATE OF FILING

The undersigned hereby certifies that Opposer Integrated Management Information, Inc.'s Redacted Trial Brief for Public Viewing was filed electronically under seal with the Trademark Trial and Appeal Board on this 24th day of April, 2012.

/s/ Cheryl L. Burbach

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposer Integrated Management Information, Inc.'s Redacted Trial Brief for Public Viewing has been served upon Applicant via U.S. mail, postage prepaid, on this 24th day of April, 2012 at the following address:

Frank W. Barrie
117 South Pine Avenue
Albany, New York 12208

/s/ Cheryl L. Burbach